

REMARKS

Claims 2 and 16 have been amended to more particularly point out the claimed subject matter. The claim amendments are fully supported by the specification (e.g., page 13, lines 9-14; Examples 5, 7, and 9-10 on pages 21-27) and original claims (e.g., claim 1). No new matter has been introduced and no new issue has been raised. These amendments have been made solely to expedite prosecution of the application. Applicants reserve the right to pursue claims of similar or differing scope in the future.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised in the Office Action are addressed below in the order they were raised by the Examiner.

Double Patenting

Claims 2, 9-12, 16, 20, and 24-25 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 3-7, and 9-10 of U.S. Patent No. 6,291,667 in view of Uchida et al. (US Patent No. 6,150,092).

Applicants respectfully request that the Examiner hold this rejection in abeyance until allowable subject matter is found, at which point, Applicants may submit a terminal disclaimer as appropriate with respect to U.S. Patent No. 6,291,667.

Applicants provide arguments below that Uchida et al. fail to render the instant claims obvious, either singly or in combination with other cited art.

Claim Rejections under 35 USC § 103(a)

The Examiner maintains the rejection of claims 2, 9-12, 16, 20, and 24-25 under 35 USC § 103(a) as allegedly being unpatentable over Uchida et al. (U.S. Pat. No. 6,150,092) in view of Robinson et al. (5,814,620; 5,710,136; and 5,801,156). Applicants respectfully traverse.

Applicants maintain the arguments of record with respect to the combination of references and contend that the combination of references cited by the Examiner fail to disclose the particular combination of elements presently claimed.

Nevertheless, solely to expedite prosecution of the present application, Applicants have amended independent claims 2 and 16 to more particularly point out the claimed subject matter. The claims as amended relate to an antisense oligonucleotide directed against VEGF, wherein said oligonucleotide comprises a plurality of phosphorothioate moieties and has a sequence selected from the group consisting of SEQ ID NOS: 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 20, 21, 28 and 29, wherein said antisense oligonucleotide inhibits proliferation of Kaposi's Sarcoma cells.

Pursuant to MPEP 2143 and in view of *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Applicants submit that the cited references, either singly or in combination, do not teach all the claim limitations, including, but not limited to: (1) the specific oligonucleotide sequences such as SEQ ID NOs: 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 20, 21, 28 and 29, either in the unmodified form or the modified form; and (2) an antisense oligonucleotide that inhibits proliferation of Kaposi's Sarcoma cells.

Further, Applicants submit that the cited references, either singly or in combination, do not inherently teach the claim limitations with respect to an antisense oligonucleotide that inhibits proliferation of Kaposi's Sarcoma cells. Inherent characteristics cannot be obvious to one of ordinary skill in the art. MPEP 2112 clearly points out that “[T]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Further, one court observed that “a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.” *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Accordingly, the cited reference fails to teach each and every limitation of the claimed invention.

Moreover, Applicants submit that Uchida et al. fail to disclose any reasons to select and make the oligonucleotide sequences as claimed. The Office Action fails to point out any express disclosure which would have motivated one of ordinary skill in the art to select the claimed invention. Applicants further emphasize that the instant specification discloses the unexpected results that the claimed oligonucleotides substantially inhibited cancer cell proliferation in cultured cells and in animal models (see, e.g., Examples 3-7 and 9-11 on pages 19-28).

Accordingly, Applicants submit that all of the pending claims are non-obvious in view of Uchida et al. and the defects of Uchida et al. are not cured by the other cited references. Applicants assert that the claims are not obvious in view of all cited references. Applicants respectfully request reconsideration and withdrawal of the rejection of the pending claims under 35 USC § 103.

CONCLUSION

Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims are now in condition for allowance and early notification to this effect is earnestly solicited. Any questions arising from this submission may be directed to the undersigned at (617) 951-7000. If there are any fees due in connection with the filing of this submission, please charge the fees to our **Deposit Account No. 18-1945**, under **VASG-P02-003**.

Dated: August 8, 2007

Respectfully submitted,

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